

Docket No.: 071957-1102

Patent

REMARKS

Claims 1-36 are presently pending in the instant application, with claims 1-20 currently under examination. In the present submission, Applicant amended claims 2, 7, and 10. The amended claims do not introduce new matter or require a new search. Rather, the amendments to the claims made herein merely correct typographical errors in the claims.

Notwithstanding the foregoing, Applicant expressly reserves the right to pursue subject matter no longer claimed in the instant application in one or more applications which may claim priority hereto. Applicant respectfully requests reconsideration of the claimed invention in view of the foregoing amendments and the following remarks.

*Non Art-Related Remarks*35 U.S.C. § 112, Second Paragraph

Applicant respectfully submits that the foregoing amendments to the claims, which correct typographical errors, render moot the rejection of claims 2, 6, 7, and 10 under 35 U.S.C. § 112, second paragraph, as allegedly being indefinite for failing to particularly point out and distinctly claim the present invention. Applicant gratefully acknowledges the Examiner's efforts in identifying these typographical errors.

*Art-Related Remarks*35 U.S.C. § 103

Applicant respectfully traverses the rejection of claims 1-20 under 35 U.S.C. § 103(a) as allegedly being unpatentable over Karkmann *et al.*, *J. Immunol. Meth.* 230: 113-20 (1999) in view of McKinley *et al.*, *Laboratory Investigation* 65: 622-30 (1991) or Merz *et al.*, *Laboratory Investigation* 73: 149-56 (1995).

The present claims recite the use of a medium comprising a chaotropic agent to wash cells labeled by tyramide deposition methods. As discussed in the prior response to a similar rejection (relying on different secondary references), the primary reference relied upon in the rejection does not disclose the use of chaotropic agents in tyramide staining methods at all.

Docket No.: 071957-1102
Patent

As in the previous rejection, which was withdrawn by the Examiner, the secondary references are completely unrelated to flow cytometry. The McKinley *et al.* publication is directed to immunohistochemical staining of materials on glass slides; while the Merz *et al.* publication is directed to staining of specimens for electron microscopy. Nothing of record indicates that methods intended for these types of applications are in any way related to flow cytometric methods.

Moreover, nothing in either secondary publication indicates that cells should be contacted with a chaotropic agent *following* the deposition of a staining material, tyramide or otherwise, as recited in the instant claims. Rather, the McKinley *et al.* publication indicates that a chaotropic agent should be used in advance of staining in order to permeabilize cells. The Merz *et al.* publication does not refer to use of chaotropic agent for any purpose.

Applicant respectfully submits that the skilled artisan would not have a motivation to modify flow cytometric methods with procedures that are unrelated to flow cytometry, or have any reasonable expectation that such a combination would be successful. Such a combination of publications has only been offered in hindsight, relying on the present application as a guide through the prior art. Moreover, even if the publications are combined as suggested by the Examiner, the instantly claimed methods are not obtained.

Because no *prima facie* case of obviousness has been established, Applicant respectfully requests that the rejections under 35 U.S.C. §103 be reconsidered and withdrawn.


Docket No.: 071957-1102
Patent**CONCLUSION**

In view of the foregoing remarks, Applicant respectfully submits that the pending claims are in condition for allowance. An early notice to that effect is earnestly solicited. Should any matters remain outstanding, the Examiner is encouraged to contact the undersigned at the telephone number listed below so that they may be resolved without the need for additional action and response thereto.

Respectfully submitted,

Date: _____

FOLEY & LARDNER
P.O. Box 80278
San Diego, CA 92138
Telephone: 858-847-6721
Facsimile: 858-792-6773

By 
For Richard J. Warburg,
Michael Whittaker
Registration No. 46,230